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In re Application of	:	OFFICE OF PETITIONS
Soong et al.	:	
Application No.: 10/065988	:	ON PETITION
Filing or 371(c) Date: 12/06/2002	:	
Attorney Docket Number: P003	:	

This is a decision on the Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. § 1.137(b), filed November 6, 2006.

This Petition is hereby **dismissed**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Request for Reconsideration of Petition under [insert the applicable code section]". This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

The above-identified application became abandoned for failure to timely reply to the non-final office action, mailed April 19, 2005. The Office action set a three (3) period for reply. Extensions of time under 37 CFR 1.136(a) were available. No reply having been received, the application became abandoned on July 10, 2005. A Notice of Abandonment was mailed April 20, 2006.

Applicant filed petitions to withdraw the holding of abandonment on April 23, 2006; June 30, 2006 and August 17, 2006, which were dismissed in Decisions mailed June 23, 2006 and September 20, 2006, for failing to meet the requirements of a grantable petition under 37 CFR 1.181.

The November 11, 2006 petition

Applicant files a petition to revive the application on November 11, 2006, however, no reply to the April 19, 2005 Office action has been filed. It was also noted that, in an Interview Summary mailed April 7, 2006, the Examiner noted that Mr. Soong "agreed to abandon this case for now...."

The Decision dismissing the November 11, 2006 petition

A Decision dismissing the November 11, 2006 petition was mailed April 4, 2004. The Decision noted that Applicant had made a deliberate decision to permit this application to be abandoned when he "agreed to abandon this case for now". Applicant was informed that an intentional abandonment of an application, or an intentional delay in seeking the revival of an abandoned application, precludes a finding of unavoidable or unintentional delay pursuant to 37 CFR 1.137.

The present renewed petition

Applicant files the present renewed petition and provides the following:

1. On September 20, 2005, Applicant avers that he sent a fax to the Examiner's personal fax number, "in response to her Office action after talking to her a few times," but the fax never reached her.
2. In the early part of 2006, Applicant states that he re-connected with Examiner Chow and discussed the application with the Examiner.
3. On April 13, 2006, Applicant states that, in conversation with the Examiner, he was instructed that in order to continue processing the application, they would first need to abandon the case and then revive it. Applicant cites to the Interview Summary that states that "Mr. Chow agrees to abandon this case for now, and he will revised it later. Mr. Chow prefers to have this case to be assigned to Examiner Chow when this case is revised since Chow has spent a lot of time working on this case. Examiner Chow has informed her SPE Ms. Wei Zhen, hopefully this case will be reassigned to Chow when it is revised."
4. Applicant states that lastly, he was told by another examiner that he should be able to withdraw its holding pattern. The October 28, (filed November 6, 2006) petition was then filed.

Applicable Law, Rules and MPEP

A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

Analysis

A review of the application file reveals that Applicant filed petitions to withdraw the holding of abandonment on April 23, 2006; June 30, 2006 and August 17, 2006, wherein Applicant alleged non-receipt of the Office action. Now Applicant states that a response to the Office action was sent to the Examiner on December 20, 2005, and includes that he had discussed the application with the Examiner "a few times" before sending the response. Applicant next states that he re-connected with the Examiner "in the early part of 2006" and was discussing the application with the Examiner. Applicant states that "we knew all along that our claims were patentable, have sufficient value, and justified the financial expenses." However, on April 19, 2005, this Office mailed a non-final rejection wherein all claims were rejected under 35 U.S.C. § 102. As such, it appears that the claims were not patentable. Applicant has not provided any evidence to corroborate his assertion that the claims were patentable.

Applicant next states that he was instructed that in order to continue processing the application, they would first need to abandon the case and then revive it. However, a review of the Interview Summary reveals that Applicant agreed to abandon this case for now, and revise (amend) it later, as opposed to reviving the case. An agreement to abandon the case for now is consistent with the Office action wherein all claims were rejected under 35 U.S.C. § 102.

As stated in the Decision dismissing the November 11, 2006 petition, an applicant is unable to make the statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional, where there is shown to be intentional delay.

The MPEP provides

A delay resulting from a deliberately chosen course of action on the part of the applicant does not become an "unintentional" delay within the meaning of 37 CFR 1.137(b) because:

- (A) the applicant does not consider the claims to be patentable over the references relied upon in an outstanding Office action;
- (B) the applicant does not consider the allowed or patentable claims to be of sufficient breadth or scope to justify the financial expense of obtaining a patent;
- (C) the applicant does not consider any patent to be of sufficient value to justify the financial expense of obtaining the patent;
- (D) the applicant does not consider any patent to be of sufficient value to maintain an interest in obtaining the patent; or
- (E) the applicant remains interested in eventually obtaining a patent, but simply seeks to defer patent fees and patent prosecution expenses.

Likewise, a change in circumstances that occurred subsequent to the abandonment of an application does not render "unintentional" the delay resulting from a previous deliberate decision to permit an application to be abandoned. These matters simply confuse the question of whether there was a deliberate decision not to continue

the prosecution of an application with why there was a deliberate decision not to continue the prosecution of an application.

D. Delay Until the Filing of a Grantable Petition

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137:

- (A) the delay in reply that originally resulted in the abandonment;
- (B) the delay in filing an initial petition pursuant to 37 CFR 1.137 to revive the application; and
- (C) the delay in filing a grantable petition pursuant to 37 CFR 1.137 to revive the application.

As discussed above, the abandonment of an application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b), where the applicant deliberately permits the application to become abandoned. See Application of G, 11 USPQ2d at 1380. Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). An intentional delay resulting from a deliberate course of action chosen by the applicant is not affected by:

- (A) the correctness of the applicant's (or applicant's representative's) decision to abandon the application or not to seek or persist in seeking revival of the application;
- (B) the correctness or propriety of a rejection, or other objection, requirement, or decision by the Office; or
- (C) the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision not to seek or persist in seeking revival.

Obviously, delaying the revival of an abandoned application, by a deliberately chosen course of action, until the industry or a competitor shows an interest in the invention is the antithesis of an "unavoidable" or "unintentional" delay. An intentional abandonment of an application, or an intentional delay in seeking the revival of an abandoned application, precludes a finding of unavoidable or unintentional delay pursuant to 37 CFR 1.137. See *Maldague*, 10 USPQ2d at 1478.

Conclusion

Applicant has failed to demonstrate that the abandonment of the application was not intentional. Applicant must provide evidence that supports his assertion that he knew the claims were patentable in early part of 2006. Copies of communications that support this assertion are required.

Applicant must also provide evidence of the efforts made to prosecute the application while the case was still pending. Copies of all communications relevant to the prosecution of this application for the period between April 19, 2005 and December 20, 2005 are required, including the response to the Office action sent via fax on December 20, 2005.

After a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. Therefore, it is extremely important that petitioner supply any and all relevant information and documentation with his request for reconsideration. The Director's decision will be based solely on the administrative record in existence. Petitioner should remember that it is not enough that the delay was unintentional; petitioner must prove that the delay was unintentional. A petition will not be granted if petitioner provides insufficient evidence to 'show' that the delay was unintentional. Therefore, if a request for reconsideration is filed, it must establish that the entire delay in filing the reply was unintentional.

Further correspondence with respect to this matter should be addressed as follows:

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Telephone inquiries concerning this petition Decision should be directed to the undersigned at (571) 272-3232.



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